

Remarks/Arguments:

The applicant would first like to thank the Examiner for holding a telephonic Interview on September 20, 2006. During that interview, the Examiner was very helpful in suggesting claim language to overcome the art of record. The applicant also appreciates the follow-up discussions that the applicant's representative, Christian M. Bauer, had with the Examiner. Consistent with those discussions, the applicant has amended claims to further clarify that which he regards as the invention, and provides arguments as to the nonobviousness of the claimed invention in view of the cited prior art.

With this response, claims 1, 8, 9, 21, and 22 are amended for improved clarity. Support for the clarifying amendments to claims 1, 21, and 22 are found in the Figures, particularly Figures 1A, 1B, 2A, and 2B. Support for the amendments to claims 8 and 9 are found at Figures 4C and 4E. No new matter has been added. Claims 1-22 are the pending claims.

I. Rejections under 35 U.S.C. § 112

Claims 8 and 9 stand rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement. With the amendments to these claims, the applicant submits that this rejection is now moot.

II. Rejections under 35 U.S.C. § 102

Claims 1, 2, 10, and 19-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by DeVito (U.S. Patent No. 5,960,572). Claim 22 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Mahoney et al. (U.S. Patent No. 6,957,755).

A. Lack of Anticipation by DeVito

The Office Action states that DeVito anticipates claims 1 and 21 because it discloses a mounting apparatus (28) affixed to the rear panel to attached device holder (12) to the vehicle. Using this characterization of DeVito, the applicant submits that the amendments to the claims distinguish the claimed invention from that which is disclosed in DeVito.

For discussion purposes, Figure 2 of DeVito is reproduced below.

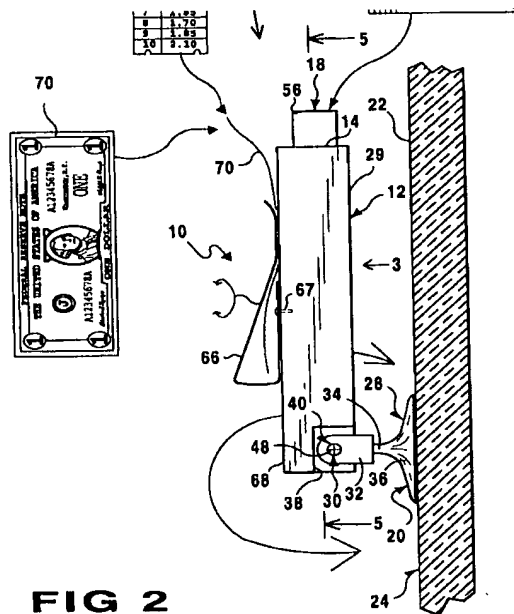


FIG 2

Claim 1 was amended to clarify aspects of the inventive electronic toll pass device of the present invention that distinguish it from DeVito for at least the following reasons. Accordingly, claim 1 recites:

a front panel having a length and a width substantially equal to the length and the width of the rear panel, the front panel disposed opposite to and spaced apart from the rear panel along the length and width of the front panel, and a retaining device attached to the front panel;

side plates having a length substantially equal to the length of the rear panel and the front panel and a width that is less than the length of the side plates;

a base panel connecting the front panel, rear panel, and side plates together to define an opening adapted to removably receive and retain the electronic toll pass device, the base panel disposed opposite the opening . . .

First, amended claim 1 requires the toll pass device to have "a front panel having a length and a width substantially equal to the length and the width of the rear panel, the front panel disposed opposite to and spaced apart from the rear panel along the length and width of the front panel," and "side plates having a length substantially equal to the length of the rear

panel and the front panel and a width that is less than the length of the side plates." Figure 2 of DeVito is a side view of the DeVito device. Applicant's amended claim clarifies the side panels have a width that is less than the width of the front and rear panels. Thus, the surface of lead line 12 and the surface of lead line 68 of the device in DeVito are comparable to the front and rear panels of the applicant's claimed invention. However, the amended claims require the "front panel ha[s] a length and a width substantially equal to the length and the width of the rear panel." In contrast, the surface of lead line 12 is shorter than surface of lead line 68 in DeVito because of the pivoting assembly 40.

Second, amended claim 1 requires "a mounting apparatus fixedly and directly mounted to the rear panel for attaching the device holder to the vehicle glass." (Emphasis added.) In contrast, DeVito discloses that mounting apparatus 28 is attached via the angularly adjusting facility 30 and is pivotably adjustable by means of the pivoting assembly 40.

Third, claim 1 requires the mounting apparatus to be directly mounted to the rear panel. In contrast, DeVito attaches suction cup 28 indirectly to the rear panel through the intermediary component, the angularly adjusting facility 30, which itself comprises base portion 32 and shaft portion 34. See col. 4, lines 59-63. The applicant submits the amendments to claim 1 distinguish the invention from DeVito. Accordingly, the applicant requests reconsideration of claim 1.

Claim 21 was amended to clarify aspects of the inventive electronic toll pass device of the present invention that distinguish it from DeVito for at least the following reasons. Accordingly, claim 21 recites:

a rear panel having a length and a width;

a mounting apparatus comprising at least one suction cup affixed to a center portion of the rear panel for attaching the device holder to the vehicle glass;

a front panel disposed opposite to and spaced apart from the rear panel, having a length and a width substantially equal to the length and width of the rear panel;

a retaining device attached to the front panel, the retaining device selected from the group consisting of a coin holder, picture holder, grasshopper clip, and eyeglass holder;

side plates having a length substantially equal to the length of the rear and front panel and a width that is less than the width of the front and rear panel; and

a base panel connecting the front panel, rear panel, and side plates to define an opening adapted to removably receive

and retain the electronic toll pass device, the base panel disposed opposite the opening.

First, if the suction cup 28 of DeVito is characterized as mounted to the base panel, then it does not anticipate claim 21 because claim 21 requires "the base panel [is] disposed opposite the opening." The applicant submits that pivoting assembly 40 of the device of DeVito is not mounted opposite the opening for the electronic toll pass device 18.

Second, if the suction cup 28 of DeVito is characterized as mounted to the rear panel, it is not mounted at a center portion of the rear panel as required by claim 21. Claim 21 requires "a mounting apparatus comprising at least one suction cup affixed to a center portion of the rear panel for attaching the device holder to the vehicle glass." In contrast, pivoting assembly 40 of the device in DeVito may be considered part of rear panel surface 12, however, the applicant submits that it is not positioned in the center of that surface 12.

The applicant submits the amendments to claim 21 distinguish the invention from DeVito. Accordingly, the applicant requests reconsideration of claim 21.

B. Lack of Anticipation by Mahoney et al.

The Office Action states that Mahoney et al. anticipates claim 22 because it teaches "a first surface (14), a middle surface (14.1) and a second surface (12). . . wherein the second surface (12) and middle surface (14.1) defines [an opening for] the retaining device (11) along substantially the entire length of the second (12) and middle (14.1) surfaces." The applicant respectfully disagrees.

For discussion purposes, Figure 2 of Mahoney et al is reproduced below.

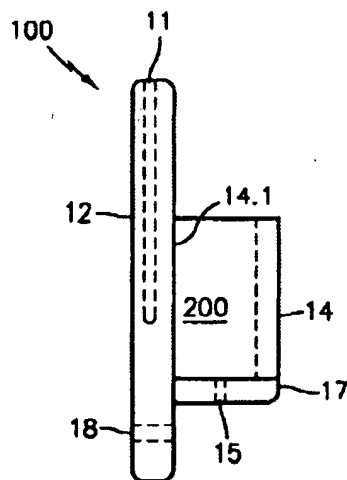


FIG. 2

Claim 22 is amended to clarify that "the second and middle surface define a second opening along substantially the entire surface of the second and middle surface." (Emphasis added.) According to the characterization in the Office Action, the second surface of Mahoney et al. is that surface of lead line 12, and the middle surface is that surface of lead line 14.1. Therefore, the spaced defined between these two surfaces is cavity 11.

The applicant submits that cavity 11 extends only partially along the first and middle surfaces and not along substantially the entire surface between the second and middle surface as required by amended claim 22. Moreover, the applicant submits that if cavity 11 of Mahoney et al. were extended along the entire length of the first 12 and middle 14.1 surfaces, cavity 11 would interfere with the function of mounting hole 18. For this additional reason, the applicant submits that claim 22 is neither taught nor suggested by Mahoney et al. The applicant respectfully requests reconsideration of claim 22.

III. Rejections under 35 U.S.C. § 103

Claims 2-7, 10-18 stand rejected under 35 U.S.C. § 103(a) in view of the DeVito reference in combination with numerous other references. The rejections are summarized below:

DeVito and Pitts (U.S. Patent No. 1,739,801) - Claim 3;
DeVito and Treske (U.S. Patent No. 5,592,767) - Claim 4;
DeVito, Treske, and Elnekaveh (U.S. Patent No. 6,823,910) - Claims 5 and 6;
DeVito and Lee (U.S. Patent No. 5,046,696) - Claim 7;
DeVito and Bolanos (U.S. Patent No. 6,427,836) - Claim 11;
DeVito, Bolanos, and Arraut (U.S. Patent No. 6,886,283) - Claims 12-14;
DeVito and Mandel et al. (U.S. Patent No. 6,053,310) - Claim 15;
DeVito and House (U.S. Patent No. 5,881,904) - Claims 16 and 18; and
DeVito, House, Mahoney et al. - Claim 17.

With respect to claims 19 and 20, the Office Action fails to mention the status of these claims. Nevertheless, the applicant respectfully submits that these claims recite patentable subject matter and request notification to that effect.

Claims 2-20 depend either directly or indirectly from claim 1. Because DeVito fails to teach each and every feature of the invention in claim 1 and the secondary references fails to fill the shortcomings of DeVito, the applicant submits that the dependent claims are not obvious in view the above combination of references. Reconsideration of claims 2-18 is respectfully requested.

IV. The Pitts Reference

To advance prosecution of this application, the applicant provides comments with respect to the Pitts reference in combination with any of the other cited references as a basis for an obviousness rejection under 35 U.S.C. § 103.

The basis for an obviousness rejection under 35 U.S.C. § 103 is determined by the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Those factual inquiries begin with (A) determining the scope and content of the prior art. Next, the analysis requires the Office to (B) ascertain the differences between the prior art and the claims at issue. Then, (C) the level of ordinary skill in the art is resolved. And finally, (D) objective evidence present in the application indicating obviousness or nonobviousness is considered. The Federal Circuit has interpreted this inquiry to require that for the Office to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (the "teaching-suggestion-motivation test"). *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2142. Although the applicant recognizes

that this standard may change depending on the decision of the Supreme Court case in *KSR International v. Teleflex* (On Petition for Certiorari), the applicant submits that as of the date of this Response, the teaching-suggestion-motivation test remains the applicable standard.

Pitts is directed to an advertising device that is a receptacle for holding removable advertising circulars, cards, or other matter, and which receptacle is provided with a suction cup for mounting to a smooth surface. Page 1, lines 1-6. Nowhere in Pitts does the applicant find a teaching or a disclosure that the receptacle is contemplated to be mounted inside a vehicle, let alone for retaining an electronic toll pass device. In fact, the applicant submits that if the receptacle of Pitts is used to hold an electronic toll pass device, such a use is contrary to the purpose of the Pitts' receptacle. Pitts states that the purpose of the receptacle is to hold removable advertising media for a recipient to take. In contrast to this purpose, the claimed electronic toll pass device holder is typically mounted inside the vehicle on a glass surface, such as on the front windshield of the vehicle. The applicant submits that such a location is not conducive for a device that holds removable advertising media for a recipient to take. Therefore, the receptacle of Pitts would have to be modified to teach the feature of the claimed invention which requires the device be adapted to retain an electronic toll pass device. Accordingly, it is well-established law that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

In addition, the amended claims require that the electronic toll pass device holder have a retaining device attached to the front panel of the electronic toll pass device holder. Exemplary retaining devices of the present invention include a business card holder, a grasshopper clip, and eyeglass clip, to name a few. Pitts fails to disclose such a retaining device. And, the applicant submits that there is no motivation for one of ordinary skill in the art to add such a retaining device to the receptacle of Pitts.

As discussed above, the purpose of Pitts is to hold removable advertising media for a recipient to take. Adding a business card holder or other retaining device to hold more media would be redundant. Adding a sunglass clip would be similarly nonsensical. Although one could argue that there is motivation for one of ordinary skill in the art to add a retaining device to the receptacle of Pitts such that it can hold more advertising media, this assertion erroneously assumes that the receptacle of Pitts needs improvement and that it does not fulfill its intended purpose, which is expressly identified at page 1, lines 1-6. Furthermore, this motivation ignores the fact that advertising media would no longer be placed in the main receptacle. For the modification to teach all the features of the claimed invention, all the advertising media is removed and replaced with the electronic toll pass device. With this modification, the applicant submits that one of ordinary skill in the art would actually be decreasing the capacity of the receptacle to hold advertising media, not increasing its capacity as suggested by this motivation. For this additional reason, the applicant submits that there is

no motivation for one of ordinary skill in the art to modify the receptacle of Pitts to include a retaining device.

V. Conclusion

The applicant has amended the independent claims to clarify that which is regarded as the invention, which is distinguishable from at least the DeVito and the Mahoney et al. references. The applicant also submits that the pending claims are not taught or suggested by the combination of DeVito and the references cited in the Final Office Action. Additionally, the applicant has provided comments with respect to the Pitts reference in response to the discussions with the Examiner. Reconsideration of the claims is respectfully requested.

Respectfully submitted,



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